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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,424	03/07/2006	Wolfgang Brunner	23336-US	6332

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EXAMINER	
SASAKI, SHOGO	
ART UNIT	PAPER NUMBER
1773	

NOTIFICATION DATE	DELIVERY MODE
11/23/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/561,424	BRUNNER, WOLFGANG	
	Examiner	Art Unit	
	Shogo Sasaki	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *9/16/2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,9 and 10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4, 9 and 10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *5/29/2009* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Amendments to the claims are acknowledged. Cancellations of claims 5-8 and 11-13 are also acknowledged.

Claim Interpretations

2. Regarding claim 1, "one or more reaction vessels" and "a lid of one of the reaction vessel" are not recited as part of the claimed subject matter. It is noted that articles worked upon do not further structurally limit an apparatus claim. It appears that applicant attempts to further define the claimed elements in relationship to how applicant intends for the respective elements to be used or function with the unclaimed reaction vessel and lid. The structure of the device is not defined or structurally limited by the intended use/function with other unclaimed elements. Also it is noted that the recitation "can be," "can apply," and "when held by the gripping jaws" in lines 26 and 29-30 indicates a conditional use of the claimed apparatus with the unclaimed "one or more reaction vessels" and "a lid for the reaction vessel." As previously stated, intended use and/or conditional usage do not further structurally limit a claimed apparatus. It is further noted that a lid for a vessel is not limited to a screw cap (See the 112 rejection below).

Claim Objections

3. Regarding claim 1, the recitation "one or more reaction vessel" in line 3 renders said claim unclear, because it is not clear if it is the same as the "one or more reaction vessel" recited in the preamble of said claim or some other one or more reaction vessel.

4. Regarding claim 2, the recitation should be for e.g., “wherein the gripping jaws comprise insertion slopes at the lower edge of the gripping surfaces.” (See [0042] of the instant application and the 112 rejection below. The slopes do not adjoin the gripping surface as recited.)

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-4, 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, it is unclear how said rotating mechanism comprising the gripper, as recited, can “close” and “open” a reaction vessel comprising a lid. The claim does not recite that said rotation mechanism comprises a mechanism that rotates the gripper in clock and/or counter-clock wise (with respect to the longitudinal axis of a reaction vessel). It is further noted that a lid for a vessel is not limited to a screw cap. It could be any type of lid. Thus the rotation of the rotating mechanism is not limited to a rotation with respect to the longitudinal axis of a reaction vessel. Any rotating

mechanism with a gripper (e.g., wheel with a rubber gripper) capable of rotating in any direction around a lid that can knock off said lid appears to meet the claim.

Regarding claim 2, it is unclear where insertion slops are located on the gripping jaws or the surface. According to the specification ([0042]: e.g., element 27), the slopes do not adjoin the gripping surfaces as recited. It is the lower edge of the gripping surface (jaw) that comprises the slope. If the gripping surfaces of the gripper are adjoined, it is unclear how a passive gripper disclosed and claimed can grip the lid of the reaction vessel. Furthermore, the recitation “the lower edge” lacks antecedent basis. The jaws with surfaces of the gripper, as recited, do not necessarily comprise lower edges.

Regarding claim 3, the “direction of rotation" is not a structural element. It is unclear how other elements can be defined relative to the direction of rotation. Is the direction of the rotation defined by the rotation mechanism or the rotated gripper?

Regarding claim 4, the “one or more reaction vessels” and the “a lid of one of the reaction vessel” are not recited as part of the claimed subject matter. Thus it is unclear how one would be able to ascertain the height of the web.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marino (US 6132684) in view of Besnier (US 5533407), and further in view of Burt (US 4674340).

Regarding claim 1-4, Marino discloses a holding apparatus for holding resilient plastic tubes/vessels (abstract; entire disclosure; and Fig. 1-12) comprising:

- three perforated plates (102, 104 and 106) arranged one above the other as a bottom plate (Fig. 8), a middle plate and a top plate, each of the perforated plates having a plurality of openings (Fig. 1-12) for holding tubes/vessels;
- the top plate and the bottom plate being fixed in a stationary position with the openings in the top and bottom perforated plates directly aligned (column 4, lines 13-17; Fig. 6, 8 and 10), and the middle perforated plate is capable of sliding between a first position in which the openings in the middle perforated plate are aligned with the openings of the top and bottom perforated plates, and a second position in which the openings are arranged somewhat offset relative to the openings of the top and bottom perforated plates, so that a reaction vessel inserted in the openings of the perforated plates is immobilized (column 3, line 60-column 11, line 59);

- means for moving and fixing (Fig. 5, 7-9) the middle perforated plate in the second position;
- wherein the middle perforated plate is mounted so as to slide in a single direction of sliding (column 3, line 60-column 11, line 59); and
- wherein the openings in the direction of sliding are wider than those at right-angles to the direction of sliding (column 3, line 60-column 11, line 59).

Marino further discloses that the holding force is sufficient to enable the cap of tube/vessel placed in the openings to be screwed off without the tube/vessel from rotating in its respective tube accommodating openings (column 10, lines 18-29).

However Marino does not explicitly disclose the rotating mechanism with the gripper for screwing on or off the lids of the vessels.

Besnier discloses a device (Fig. 1-7; and C4-8) comprising:

- a holding device for holding vessels (Fig. 4: 38; 40);
- a gripper (Fig. 6: 76), wherein the gripper has gripping jaws (106/108) with insertion slope (Fig. 6: the bottom edge of 106); and
- a rotating mechanism for rotatable holding of the gripper for screwing and unscrewing a cap 16 (Fig. 6: 74, 88).

The examiner asserts that it would have been obvious to one having ordinary skill in the art at the time of the invention to use the rotation assembly for screwing and unscrewing as taught by Besnier in view of Marino's teaching (column 10, lines 18-29).

Besnier modified Marino however does not teach a passive gripper without the active gripping/operating device.

Burt discloses a device (Fig. 1-6) comprising:

- a holding device (Fig. 1: 4 and 10; and Fig. 2) with a clamping mechanism (Fig. 2).;
- a gripper (74), wherein the gripper has gripping jaws (82) and the gripper has no active operating device for opening and closing the gripping jaws;
- a rotating mechanism for rotatable holding of the gripper (64, 66, 68, 70 and 80);
- wherein the gripping jaws have insertion slopes (84);
- wherein the gripping jaws have on their gripping surfaces one or more cutting webs running at right-angles to the direction of rotation (88: The cutting web would provide friction to the lid for the rotation. It is noted in view of the interview that the claim does not say that the gripper holds the lid when the lid is lifted off the vessel. It is also unclear how the lid is capable of sticking to the claimed passive gripper with no active operating device.); and
- wherein the cutting web projects beyond the gripping surface (Fig. 4 and 5).

The examiner asserts that one of ordinary skill would have been motivated to use a different gripper taught by Burt in place of gripper of Besnier modified Marino. Screwing and unscrewing action of Besnier would not be compromised by this modification.

All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

10. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marino (US 6132684) in view of Besnier (US 5533407), further in view of Burt (US 4674340), and further in view of Hansen et al. (US 2003/0038071).

Regarding claims 9 and 10, modified Marino discloses all of the limitations as set forth above. However modified Marino does not explicitly teach the projections provided at the holes of plates.

Hansen et al. disclose a holding apparatus similar to the one disclosed by Marino (See Fig. 2-5 and 14-20). The holes (142) on plates of Hansen et al. include edges 144 which are configured to engage with projections 146 (pointed towards the interior of the hole/opening in all direction) on the exterior of the tubes 120 to prevent the tubes 120 from rotating within the openings 142 when, for example, a cap (not shown) is being screwed onto a top of the tube 120 ([0041]). The projections are merely provided for giving the extra traction/friction to firmly hold the tubes in place. The examiner asserts that this very idea is explicitly taught by Hansen et al.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the invention of modified Marino to incorporate projections as taught by Hansen et al., for the purpose of giving extra traction to hold the tubes in

place. The claim would have been obvious because the technique for improving a particular class of devices was part of the ordinary capabilities of a person of ordinary skill in the art, in view of the teaching of the technique for improvement in other situations.

Response to Arguments

11. Applicant's arguments filed 9/16/2010 have been fully considered.

12. The objection to claim 10 is withdrawn.

13. The 112 rejections from the previous office action are withdrawn.

14. Applicant's arguments with respect to the prior art have been considered but are moot in view of the new ground(s) of rejection.

15. It is noted, in view of the interview on 9/15/2010, that the claim does not say that the gripper holds the lid when the lid is lifted off the vessel. It is also unclear how the lid is capable of sticking to the claimed passive gripper (with no active operating device for the jaws), when the gripper holding the lid is lifted off of the vessel. The examiner suggests applicant to further structurally define the gripper and the rotating mechanism.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shogo Sasaki whose telephone number is (571)270-7071. The examiner can normally be reached on Mon-Thur, 10:00am-6:30pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SS

11/16/2010

/Brian R Gordon/

Primary Examiner, Art Unit 1773